

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2423**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hideki NAKAMURA et al.

Group Art Unit: 2423

Application No.: 10/678,214

Examiner: S. SAWAGED

Filed: October 6, 2003

Docket No.: 117454

For: DIGITAL BROADCAST RECEPTION APPARATUS

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the February 4, 2009 Office Action, Applicants respectfully request reconsideration of the application. Claims 1-13 are pending in this application.

The Office Action rejects claims 1-3, 5 and 8-13 under 35 U.S.C. §102(b) over WIPO Publication No. WO 02/067447 to Ellis et al. (hereinafter "Ellis"); rejects claim 4 under 35 U.S.C. §103(a) over Ellis in view of U.S. Patent No. 6,216,264 to Maze et al. (hereinafter "Maze"); and rejects claims 6 and 7 under 35 U.S.C. §103(a) over Ellis in view U.S. Patent No. 6,588,014 to Hayashi. Applicants respectfully traverse the rejections.

The Office Action asserts that Ellis teaches a digital broadcast reception apparatus and method that corresponds to the subject matter recited in independent claims 1 and 13. Specifically, the Office Action asserts that Ellis discloses a broadcast reception apparatus

capable of receiving a digital broadcast at page 17, lines 11-13 and as shown in Fig. 3B that corresponds to the recited "digital broadcast reception apparatus."

The Office Action supports this conclusion by asserting that: (1) Ellis discloses demultiplexer 336 that extracts digital radio data for a particular radio station from several digital radio stations that may be multiplexed with a single carrier; (2) Ellis' disclosed process of keeping track of radio preferences, at page 28, lines 22-28, corresponds to the recited "condition determination unit" of claim 1 and the corresponding feature of method claim 13; and (3) Ellis' disclosed scan feature, in which a reception apparatus briefly plays audio from available stations then switches to a next station, at page 51, lines 1-4 and as shown in Fig. 40, corresponds to the recited "wherein in the program search, a plurality of programs that match the search condition and that are contained in the received digital broadcast are presented to a user for a predetermined time in sequence" of claims 1 and 13. These assertions are flawed for at least the following reasons.

First, Ellis fails to disclose any feature which may reasonably be considered to correspond to the recited "wherein in the program search, a plurality of programs that match the search condition and that are contained in the received digital broadcast are presented to a user for a predetermined time and sequence," of claims 1 and 13. Specifically, Ellis fails to disclose that any disclosed scan function is based on, or somehow dependent on, the disclosed process of keeping track of radio preferences. Thus, the Office Action appears to apply piecemeal analysis in asserting that Ellis teaches all of the features of claims 1 and 13 and, as a result, fails to assert that such features are necessarily related in the manners recited in each of claims 1 and 13.

Second, the Office Action impermissibly combines the teachings of two mutually exclusive embodiments without providing any articulated rationale for such combination. Ellis discloses that the configuration shown in Fig. 3b, including demultiplexer 336, is an

alternative embodiment of the configuration shown in Fig. 1. In an entirely different embodiment, Ellis discloses a scan function. No technical basis is provided, either in Ellis or otherwise, for concluding that the apparatus shown in Fig. 3b is somehow capable of performing, or is necessarily related to, Ellis' disclosed scan function embodiment. In fact, it is not.

One having ordinary skill in the art would not have combined these two embodiments of Ellis with any reasonable degree of predictability. The disclosure of the present application provides that, in the case of digital broadcast reception, a user necessarily must scan through an excessive amount of programs until a desired program is found due to the large amount of information received. See specification at page 4, lines 3-16. The claimed features of the present application solve this problem at least by combining a condition determination unit with the search feature discussed above to prevent excessive reception of undesirable programs. Because Ellis fails to recognize this problem, or a similar problem, one having ordinary skill in the art, having read Ellis, would not have predictably combined the various elements of Ellis to have derived the inventions of claims 1 and 13.

Further, Maze and Hayashi fail to remedy this deficiency in Ellis.

For at least the above reasons, the applied references do not disclose, and would not have suggested, the combinations of all of the features recited in independent claims 1 and 13. Further, claims 2-12, which depend from claim 1, are also neither taught, nor would they have been suggested, by the applied references for at least the reasons discussed above, as well as for the additional features they recite.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-13 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: May 1, 2009

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